

REMARKS

By way of the present amendment, the Examiner's objections in paragraph 4 of the subject Office Action have been addressed in that claim 6 has been amended so that it is no longer a multiple dependent claim. As a result, Applicant respectfully submits that claims 6-15 are now proper under 37 C.F.R. 1.75(c).

In addition, regarding the Examiner's rejections of claims 3 and 4 in paragraph 5 of the subject Office Action, the phrase "or another biometric device" has been deleted from claim 3 by the present Amendment. As a result, Applicant respectfully submits that all claims are now proper under 35 U.S.C. 112.

In paragraph 6 of the subject Office Action, claim 1 has been rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,157,726 to Merkle et al. When the subject patent application was filed, a step was omitted from claim 1 due to a clerical error. This step: **"recording authentication data corresponding to the verification data; and"** is present in the corresponding portion of the Summary of the Invention on page 2 of the specification of the subject application. Applicant respectfully submits that it is clear that the omission of the phrase in question from claim 1 is merely a clerical error. As a result, claim 1 has been corrected by the present Amendment to include the phrase and Applicant respectfully submits that it is patentable over Merkle et al.

Merkle et al discloses a system for authenticating a hard copy of an original document, and therefore deals with two distinct documents. As described in column 2, lines 12 to 54 of Merkle et al, this is achieved by making a copy of the original document on a copying machine and at the same time attaching some kind of signature to the copy, and sending the copy to a recipient who will then, through a similar copying machine, process the copy to authenticate it.

The present invention, on the other hand, as recited in corrected claim 1, relates to a method of generating a document. The document generated is typically the first printed document, but even if it is a copy of an original, the content data of the document is not verified in relation to the original document. Significantly, the verification system of the present invention has as an object the checking of a document against a verification database in which a record of all documents created is stored, and the method of generating a document includes both the generation of verification data and the recording of authentication data corresponding to the verification data. The relevance and details of the verification database are mentioned on page 6 of the subject application, in the fourth paragraph, and described on page 8 of the subject application, from the second paragraph onwards, in more detail.

It is therefore submitted that Merkle et al relates to a different system of authentication or verification than the present invention as recited by corrected claim 1. Furthermore, Merkle et al does not disclose the recording of authentication data that corresponds to the verification data, as recited by present claim 1. It is therefore submitted that the invention as defined by corrected claim 1 is novel over the cited prior art.

In the light of the above analysis, and the correction of claim 1, Applicant respectfully submits that the Examiner's obviousness arguments with regard to claims 2 to 5 in paragraph 8 of the subject Office Action are moot and that the combination of Merkle et al with U.S. Patent No. 5,341,428 to Schatz is not of direct relevance to the present invention. Schatz relates to the identification of the holder of a document such as a check by issuing the holder with a smart card on which is recorded an encrypted card derivation number used to verify a document. (See column 3, line 30 onwards, and claim 1 of Schatz.) The system of Schatz has a different purpose

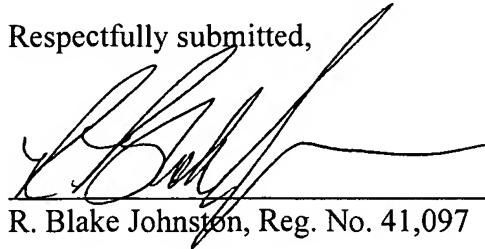
and uses a different process from that of the present invention and Applicant respectfully submits that it has no direct relevance to the method as defined in claims 2 to 5.

In paragraph 7 of the subject Office Action, the Examiner has argued that claims 16 to 18 of the subject application are anticipated by U.S. Patent No. 5,671,282 of Wolff et al. However, the passages cited by the Examiner (column 7, lines 24-29 and column 7, lines 33-43) fail to suggest or teach what is recited in claim 16. More specifically, the described system of Wolff et al stores a copy of a document such as a prescription electronically, and when the prescription is presented at a pharmacy, the entire document is scanned and the scanned version is compared with the stored version. However, there is no disclosure of the claimed combination of access control means arranged to generate user data corresponding to an authorized user; processor means for generating verification data derived from the document data and the user data, the verification data being applied to the printed document; and a database for storing an authentication record corresponding to the verification data, for use in authentication of the document. In the present invention, only the verification data need be scanned from the presented document and compared with the authentication record, which does not comprise the entire document. This is a more efficient and less complex system than that of Wolff et al. As a result, Applicant respectfully submits that claims 16 to 18 are patentable over Wolff et al.

In view of the foregoing amendments and remarks, it is believed that the application is in condition for allowance and such action is respectfully requested.

If the Examiner believes that a telephone conference would advance the prosecution of the case, it is requested that the undersigned attorney be telephoned for that purpose.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'R. Blake Johnston', is written over a horizontal line.

R. Blake Johnston, Reg. No. 41,097

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